

### REMARKS

This communication is filed in response to the Office Action dated September 29, 2010 (hereinafter "*Office Action*"). Claims 26, 28, 31, 33, 35-38, and 40 are amended. Claims 27, 29, 30, 34, and 41 are canceled. Claims 42-46 are added. Therefore, claims 26, 28, 31-33, 35-40, and 42-46 are now pending in this application.

#### *The Rejection of Claims Under 35 U.S.C. § 102(e)*

The Examiner rejected claims 26, 29-35, 40 and 41 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2002/0023021 A1 to De Souza (hereinafter "*De Souza*").<sup>1</sup> In order to anticipate a claim, a reference must disclose all of the limitations of the claim, arranged or combined in the same way as recited in the claim. The Court of Appeals for the Federal Circuit recently held

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also ***all of the limitations arranged or combined in the same way as recited in the claim***, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.”<sup>2</sup>

Applicants will show that *De Souza* does not anticipate independent claims 26, 33, and 40, and their respective dependent claims.

Each of independent claims 1 and 40, as amended, recites, in part,

enabling a content provider to send a communication directly to the device independently of the content distribution network, the communication to control a second graphical user interface at the content destination.

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<sup>1</sup> *Office Action* at 2.

<sup>2</sup> *Net MoneyIn, Inc. v. Verisign, Inc.*, No. 2007-1565 at 17. (Fed. Cir. Oct. 20, 2008) (emphasis added).

Similarly, independent claim 33, as amended, recites, in part,

a device at a content destination to:

receive a communication directly from a content provider associated with the content provider identifier, the communication being independent of the content distribution network, the communication to control a second graphical user interface at the content destination;

render the second graphical user interface at the content destination based on the receiving of the communication.

The Examiner conceded that *De Souza* does not expressly disclose a portion of a similar recitation of now-canceled claims 27, specifically, “wherein, after the linking of the content provider to the content destination, the content provider communicates directly with the content destination independently of the content distribution network.”<sup>3</sup> Therefore, because *De Souza* does not disclose all of the elements of each of independent claims 1, 33, and 40, each of independent claims 1, 33, and 40, and their respective dependent claims, are not anticipated by *De Souza*. Accordingly, Applicants respectfully request that the Examiner withdraws the rejection of claims 26, 29-35, 40 and 41 under 35 U.S.C. § 102(e).

*The Rejection of Claims Under 35 U.S.C. § 103(a)*

The Examiner rejected claims 27, 28, 36 and 37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *De Souza* in view of U.S. Patent Application Publication No. 2003/0126608 A1 to Safadi (hereinafter “*Safadi*”).<sup>4</sup>

As the Supreme Court stated in *KSR Int’l Co. v. Teleflex Inc.*,<sup>5</sup> the factual inquiries announced in *Graham v. John Deere*<sup>6</sup> (scope and content of the prior art; differences between the claimed invention and the prior art; level of ordinary skill in the art; and secondary indicia of non-obviousness), remain the foundation of any determination of obviousness.<sup>7</sup> It remains true

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<sup>3</sup> Office Action at 5.

<sup>4</sup> *Id.*

<sup>5</sup> *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

<sup>6</sup> *Graham v. John Deere*, 383 U.S. 1, 17–18 (1966).

<sup>7</sup> See Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*, Federal Register / Vol. 75, No. 169 / Wednesday, September 1, 2010 / Notices, p. 53644 (hereinafter “2010 KSR Guidelines”).

that “[t]he determination of obviousness is dependent on the facts of each case.”<sup>8</sup> Applicants have incorporated elements of claim 27 into each of the independent claims. However, Applicants will show that, under the facts of this case, independent claims 1, 33, and 40, and their respective dependent claims, are patentable over *De Souza* in view of *Safadi*.

Each of independent claims 1 and 40, as amended, recites, in part,

enabling a content provider to send a communication directly to the device independently of the content distribution network, the communication to control a second graphical user interface at the content destination.

In support of an allegation that *De Souza* discloses a similar recitation, specifically, “enabling the content provider to control a portion of a user interface presented to the user at the content destination,” the Examiner cited to *De Souza* at FIG. 2 and paragraphs [0032], [0046], [0048], and [0056]. However, *De Souza*, in the cited portions and elsewhere, merely discusses that “the device 101 downloads the representations 202-207 *from the gateway system* 106 and presents them on the display 201.”<sup>9</sup> However, downloading representations from a gateway system is not the same as “enabling a *content provider . . . to control a second graphical user interface at the content destination*,” as recited in each of independent claims 1 and 40.

Furthermore, as described above, the Examiner conceded that *De Souza* does not expressly disclose a portion of a similar recitation of now-canceled claims 27, specifically, “wherein, after the linking of the content provider to the content destination, the content provider communicates directly with the content destination independently of the content distribution network.”<sup>10</sup> Instead, in support of an allegation that *Safadi* discloses this recitation, the Examiner cited to *Safadi* at FIG. 1 and paragraphs [0025]-[0027] and [0040]-[0041].<sup>11</sup> However, *Safadi*, in the cited paragraphs and elsewhere, merely discusses that “[t]he *streaming media content* may be provided by a third party content provider 50, 52, or the system operator 40 (e.g., from content servers 30, 32).”<sup>12</sup> However, providing streaming media content is not the same as

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<sup>8</sup> *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1089 (Fed. Cir. 2008) (citing *Graham*, 383 U.S. at 17–18 (1966)).

<sup>9</sup> *De Souza* at [0046] (emphasis added).

<sup>10</sup> *Office Action* at 5.

<sup>11</sup> *Id.*

<sup>12</sup> *Safadi* at [0025].

“controlling a second graphical user interface at the content destination,” as recited in each of independent claims 1 and 40.

Independent claim 33, as amended, recites, in part,

a device at a content destination to:

receive a communication directly from a content provider associated with the content provider identifier, the communication being independent of the content distribution network, the communication to control a second graphical user interface at the content destination;

render the second graphical user interface at the content destination based on the receiving of the communication.

As described above, the Examiner conceded that *De Souza* does not expressly disclose a portion of a similar recitation of now-canceled claims 27, specifically, “wherein, after the linking of the content provider to the content destination, the content provider communicates directly with the content destination independently of the content distribution network.”<sup>13</sup> Instead, in support of an allegation that *Safadi* discloses this recitation, the Examiner cited to *Safadi* at FIG. 1 and paragraphs [0025]-[0027] and [0040]-[0041]. However, *Safadi*, in the cited paragraphs and elsewhere, merely discusses that “[t]he **streaming media content** may be provided by a third party content provider 50, 52, or the system operator 40 (e.g., from content servers 30, 32).”<sup>14</sup> However, providing streaming media content is not the same as “receiv[ing] a communication . . . to control a second graphical user interface at the content destination,” as recited in independent claim 33.

Because no combination of *De Souza* and *Safadi* teaches or suggests at least the above recitations of each of independent claims 1, 33, and 40, independent claims 1, 33, and 40, and their respective claims, are patentable over *De Souza* in view of *Safadi*.

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<sup>13</sup> *Office Action* at 5.

<sup>14</sup> *Safadi* at [0025].

The Examiner also alleged that:

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to modify *De Souza* by receiving the digital content from the content provider independently of the content distribution network as disclosed by *Safadi*. The suggestion/motivation would have been in order to provide the user additional content through the use of remote content providers using existing video delivery systems and allows third party content providers to generate additional revenue.<sup>15</sup>

Applicants respectfully disagree that one skilled in the art at the time of Applicants' invention would have combined *De Souza* with because *Safadi* because such a modification of *De Souza* would change the principle of operation of *De Souza*. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."<sup>16</sup>

*De Souza* states the following:

An advantage of this embodiment is that the content providers 107, 108, 109 now have to distribute their content and offerings only to the gateway system 106, and not to all individual consumer devices 101. This saves them from having to deploy a large and expensive transmission infrastructure, such as a cable network or a number of satellites. A single connection to the gateway system 106 allows the content providers 107, 108, 109 to (potentially) reach the entire population of the gateway system's user base.

Thus, *De Souza* disparages the idea of content providers distributing their content and offerings to individual consumer devices as "expensive" because the content provider would have to employ a large transmission infrastructure.

In contrast, *Safadi* discusses that "content providers and content servers may be available to provide streaming media content to the consumer device."<sup>17</sup> However, modifying *De Souza* such that the content providers of *De Souza* may stream media content to the consumer device would be contrary to the principle of operation of *De Souza* of preventing content providers from having to deploy a large and expensive transmission infrastructure. Therefore, one skilled in the art would not have combined *De Souza* with *Safadi*.

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<sup>15</sup> *Office Action* at 8.

<sup>16</sup> *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); see also MPEP § 2143.01.VI.

<sup>17</sup> *Safadi* at [0011].

The Examiner also rejected claims 38 and 39 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *De Souza* in view of U.S. Patent Application Publication No. 2004/0010602 A1 to Van Vleck (hereinafter “*Van Vleck*”). However, any claim depending from an allowable independent claim is also allowable.<sup>18</sup> Because claims 38 and 39 depend on claim 33, claims 38 and 39 are patentable for at least the reasons discussed above with respect to independent claim 33. Accordingly, Applicants respectfully request that the Examiner reconsiders and withdraws the rejections of claims 38 and 39 under 35 U.S.C. § 103(a).

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<sup>18</sup> See MPEP § 2143.03.

**CONCLUSION**

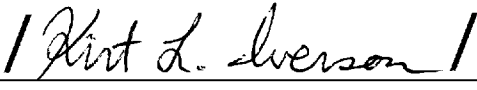
Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 660-2016 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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